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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/023,298	12/17/2001	Martin P. Madden	2815RCE	8174

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EXAMINER

AKERS, GEOFFREY R

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 09/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/023298

Applicant(s)

Madden

Examiner

Allen, 9

Group Art Unit

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—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

### Status

- ☒ Responsive to communication(s) filed on 12/17/01
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

- ☒ Claim(s) 1-8 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-8 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☒ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

### Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

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## DETAILED ACTION

1. Claims 1-8 have been examined.

### *Specification*

2. The abstract of the disclosure is objected to because it is not sufficiently explicit. It should also be no more than 150 words in length. Correction is required. See MPEP § 608.01(b).

### *Double Patenting*

3. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

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4. Claims 1-8 are rejected under 35 USC 101 double patenting as unpatentable over Madden(US Pat. No: 6,360,360). Claims 1-8 of the subject application are virtually identical to those claims as recited in subject prior patent to Madden.

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*Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-8 are rejected under 35 USC 103(a) as unpatentable over Shepard (US Pat. No: 5,970,479) and further in view of Sampson(US Pat. No: 5,802,499).

7. As per claim 1 Shepherd teaches a method using a computer system(col 4 lines 13-17) for analyzing the value(col 3 lines 45-58) of a deposit liabilities base associated with a financial institution and for originating contractual documents through which the financial institution obtains the right to sell the deposit liabilities base to a third party at a predetermined price(col 4 lines 35-42) comprising the steps of analyzing external market and internal data pertaining to the financial institution and inputting the external market data and the internal data to the computer system(col 4 lines 17-22) and calculating an estimated market value(col 4 lines 17-24) or a range of such values for the deposit liabilities base and generating a minimum of potential bid price or range of such prices(col 4 lines 25-29) for the deposit liabilities base and incorporating the generated bid price or range of such prices into the contractual documents(col 4 lines 47-55), wherein the contractual documents specify the price or range of prices which the third party will pay during a predetermined term for the deposit liabilities(col 4 lines 66-col 5 line 11)(col 5 lines 47-55).Shepherd fails to teach that this risk management contract is applied specifically to

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financial institutions' deposit liabilities as the underlying asset. Sampson teaches that financial institutions participate in his Global Credit Support System(GCSS) to hedge against declines in value of their underlying assets(col 11 lines 1-6)(col 11 lines 10-13)(col 11 lines 28-31)(col 11 lines 41-53)(Fig 2A/2B/2C). It would have been obvious to one skilled in the art at the time of the invention to combine Shepherd in view of Sampson to teach the above. The motivation for this is to extend these risk management techniques to additional items having economic value to people including intangible property.

8. As per claim 2 Shepherd teaches the method of Claim 1, further comprising the step of the financial institution exercising its right as specified in the contractual liabilities to sell the deposit liabilities base to the third party(col 5 lines 12-24). Shepherd fails to teach that the party is a financial institution. Sampson teaches that some participants in the derivatives markets are financial institutions(col 11 lines 4-6). It would have been obvious to one skilled in the art at the time of the invention to combine Shepherd in view of Sampson to teach the above. The motivation is to utilize this method for intangible assets as a class extension of traditional tangible assets.

9. As per claim 3 Shepherd teaches the method of Claim 1, wherein the external market data comprises data relating to deposit pricing practices(col 5 lines 25-40). It would have been obvious to one skilled in the art at the time of the invention to combine Shepherd in view of Sampson to teach the above. The motivation is to evaluate deposits as an underlying asset class for the purposes of pricing the associated derivatives.

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10. As per claim 4 Shepherd teaches the method of Claim 1, wherein the internal data relates to the deposit liabilities base of the selling financial institution(col 5 lines 14-18).It would have been obvious to one skilled in the art at the time of the invention to combine Shepherd in view of Sampson to teach the above. The motivation is to evaluate the asset base of a party to the contract.

11. As per claim 5 Shepherd teaches the method of Claim 1, wherein the asset base consists of money(positive or negative),goods,services,promises,credits or warrants(col 5 lines 14-18).Shepherd fails to teach that the assets consist specifically of deposit liabilities base which comprise either or both of non-interest bearing and interest bearing deposit accounts, however negative(ie liabilities) money is listed. It would have been obvious to one skilled in the art at the time of the invention to combine Shepherd in view of Sampson to teach applying these techniques to specific liabilities as a subset of the class of intangible assets. The motivation for this is to extend these methods to a designated subset of intangible assets called liabilities.

12. As per claim 6 Shepherd teaches the method of Claim 1 wherein the method of analyzing the value of the deposit liabilities base of the financial institution and originating the contractual documents is incorporated into a purchase accounting acquisition of a selling financial institution(col 19 lines 9-12)(Fig 14/1520)(col 19 lines 23-51)(Fig 15/1580).It would have been obvious at the time of the invention to combine Shepherd in view of Sampson to teach the above.The motivation for this is to derive the ultimate pricing of the options contract from a correlation with the value of the underlying assets.

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13. As per claim 7 Shepherd teaches the method of Claim 1, wherein the method includes the step of calculating the deposit liabilities base by subtracting an estimated attrition(col 23 lines 14-16)(Fig 63)(Fig 64) of the deposit liabilities base from an estimated increase of the deposit liabilities base based on newly attracted funds(col 19 lines 29-33)(Fig 13/1430-1480).Shepherd fails to specifically state that this asset base is deposit liabilities. It would have been obvious to one skilled in the art at the time of the invention to combine Shepherd in view of Sampson to teach applying the above techniques for equity indices to deposit liabilities as another intangible asset. The motivation is to extend the methods of risk management to additional subclasses of intangible assets.

14. As per claim 8 Shepherd teaches a method using a computer system(col 4 lines 13-17) for analyzing the value(col 3 lines 45-58) of a deposit liabilities base associated with a financial institution seeking to obtain the right to substitute other deposit funds not originally included in the subject deposit liabilities base, while also seeking to purchase the right to sell a deposit liabilities base, and for originating contractual documents through which the financial institution obtains the right to sell the deposit liabilities base to, a third party at a predetermined price,(col 4 lines 35-42) comprising the steps of analyzing external market data, and internal data pertaining to the financial institution and inputting the external market data and the internal data to the computer system(col 4 lines 17-22) and calculating an estimated market value(col 4 lines 17-24) or a range of such values for the deposit liabilities base and generating a minimum potential bid price or a range of such prices(col 4 lines 25-29) for the deposit liabilities base and incorporating

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the generated bid price or the range of such prices into the contractual documents(col 4 lines 47-55) wherein the contractual documents specify the price or range of prices which will be paid during a predetermined term for the deposit liabilities(col 4 line 66-col 5 line 11)(col 5 lines 47-55). Shepherd fails to teach that this risk management contract is applied specifically to financial institutions' deposit liabilities as the underlying asset. Sampson teaches that financial institutions participate in his Global Credit Support System(GCSS) to hedge against declines in value of their underlying assets(col 11 lines 1-6)(col 11 lines 10-13)(col 11 lines 28-31)(col 11 lines 41-53)(Fig 2A/2B/2C). It would have been obvious to one skilled in the art at the time of the invention to combine Shepherd in view of Sampson to teach the above. The motivation for this is to extend these risk management techniques to additional items having economic value to people including intangible property.

### *Conclusion*

#### 15. THIS ACTION IS MADE NON-FINAL.

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Any questions regarding this communication should be addressed to the examiner, Dr. Geoffrey Akers, who can be telephoned at (703)-306-5844 between the hours of 6:30 AM and 5:00 PM Monday through Friday. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Vincent Millin, SPE, may be contacted at (703)-308-1065.

GRA

September 4, 2002